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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,487	10/02/2000	Hiroataka Matsumoto	Q61016	4933

7590 07/02/2003

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EXAMINER

THORNTON, YVETTE C

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/676,487

Applicant(s)

MATSUMOTO ET AL.

Examiner

Yvette C. Thornton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-24 is/are pending in the application.
- 4a) Of the above claim(s) 3-8 and 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 21 is/are rejected.
- 7) ☒ Claim(s) 9, 10 and 22-24 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is written in reference to application number 09/676487 filed on October 2, 2000.

Request for Continued Examination (RCE)

1. The request filed on May 19, 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09/676487 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. Claims 1 and 3-24 are currently pending. Claims 3-8 and 11-20 have been withdrawn to non-election inventions.

3. The amendment to the instant claims is sufficient to overcome the rejection of the claims under 35 USC 112, 1st paragraph as set forth in paper number 11.

Claim Rejections - 35 USC § 112

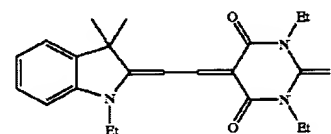
4. Claims 1, 9-10 and 21-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compounds of general formula 4 wherein G1 and G2 together form a substituted heterocycle, does not reasonably provide enablement for compounds of given formula 8 which are substituted with monovalent groups. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make all embodiments of the invention commensurate in scope with these claims. The instant specification provides for the use of some monovalent groups such as -Cl, -SO₂CH₃ and -H (pg. 25, pg. 44, compounds 62-65), it does not provide for the use of ALL monovalent groups.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

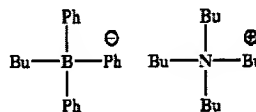
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Sorori et al. (US 6468711 B1). Sorori exemplifies in comparative example 1-2, a lithographic printing plate prepared by coating an aluminum plate with a photosensitive composition comprising (1) an ethylenically unsaturated compound; (2) a binder; (3) a titanocene photoinitiation



compound; and (4) a sensitizing dye (H-2) having the structure:

(c. 51, l. 40-c. 54, l. 35). It is the examiner's position that taught compound H-2 meets the limitation of claimed formula (8) when R^1 and R^2 are aliphatic ethyl groups; Q^3 is S; m is 1; R^h is ethyl; and R^{d-s} are each hydrogen. The said comparative example serves to establish that compound (H-2) is well known and conventional in the art. Sorori further teaches that a co-sensitizer can be used in combination with the sensitizing dye in order to improve sensitivity

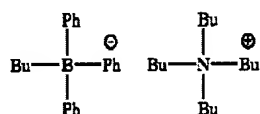


(c. 41, l. 9-c. 43, l. 35). A preferred example includes (H-6) (c. 55, l.

15-20, ex. 1-25). It is the examiner's position that compound (H-6) meets the limitations of

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claimed formula (A) when R_a^{1-3} are each an aromatic phenyl group; R_a^4 is an aliphatic butyl group and Y represents a cation. It would have been obvious to one of ordinary skill in the art, in light of the teachings of Sorori to add a co-sensitizer such as the preferred compound



(H-6) into a composition, which is well known and conventional in the

art such as that represented by comparative example 1-2 in order to improve the sensitivity of the composition.

7. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention

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was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Response to Arguments

8. Applicants argue that support for claimed formula 8 is found on page 25 of the specification. The examiner has found support for the said formula on pages 25-28 and in compounds 62-65 on page 44 of specification.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Sakurada et al. (JP 08-211552 A, machine translation) pertaining to a silver halide photographic sensitive material containing hexamethylenemerocyanine compound.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvette C. Thornton whose telephone number is 703-305-0589. The examiner can normally be reached on Monday-Thursday 8-6:30.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C. Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1495.

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A handwritten signature in black ink, reading "Yvette C. Thornton". The signature is written in a cursive style with a large, stylized "Y" and a circular flourish at the end.

Yvette Clarke Thornton

Junior Examiner

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yct

June 27, 2003